# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/595,204 | 06/16/2000 | Naokazu Nagasawa | 32739 | 1207 |

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| EXAMINER |
|---|
| BRINEY III, WALTER F |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2644 | |

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/595,204 | NAGASAWA ET AL. |
| | Examiner | Art Unit | |
| | Walter F Briney III | 2644 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on _25 October 2004_.

2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) _1-9_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-3 and 5-9_ is/are rejected.

7) ☒ Claim(s) _4_ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _22 February 2005_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

# DETAILED ACTION

## *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.      **Claims 1, 2, and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue (US**

**Patent 6,618,586).**

**Claim 1** is limited to *a telephone terminal device.*  Inoue discloses a device and

method for searching the directory memory of a portable cellular phone.  See Abstract

and figure 3.  Figure 2 depicts the main subsystems of the portable cellular telephone of

Inoue.  Inoue clearly depicts both a directory memory (6), i.e. a telephone directory

associated with at least one telephone directory memory, and a telephone number

temporary memory (7), i.e. a *temporary storage memory.*  Inoue further discloses

expanding the size of the temporary memory (7) to being larger than two, such that the

user can simply search the temporary memory (7) for numbers they wish to enter into

the directory memory (6).  See column 5, line 57 through column 6, line 4.  Since the

user has access to both the directory memory and the temporary memory, a plurality of

*user selectable directories for storing user selected phone numbers* exist.  For clarity,

the temporary memory (7) is considered both the temporary storage memory and one of

the plurality of user selectable telephone directories associated with a telephone

directory memory. Figure 3 depicts that at step S2, an entered telephone number, detected in step S1, is stored in the temporary memory (7). See column 5, lines 1-14. Subsequently, that number is entered into the directory memory (6) according to user actions instigated by the indication generated at the end of step S6, i.e. *each of the telephone directory memories storing input telephone numbers*. See column 5, lines 33-49. The order of steps followed in figure 3 indicates that registration occurs after step S6, which follows from step S3, the check to determine when a call has ended, i.e. *wherein a telephone number...is registered in at least one telephone directory memory... after making a call*. Since the user must initiate the registration process, if follows that the directory memory (6) must be *selected* before registering after a call. Therefore, Inoue anticipates all limitations of the claim.

**Claim 2** is limited to *a telephone terminal device as claimed in claim 1*, as covered by Inoue. Figure 5 of Inoue provides an exemplary memory mapping of the directory memory (6). It is clear that both *name* and other *information related to the telephone number* -- e.g. abbreviated telephone number -- are appended to the telephone number. Therefore, Inoue anticipates all limitations of the claim.

**Claim 7** is limited to *a telephone terminal device as claimed in any of claims 1 to 4*. Consider claim 1, as covered by Inoue, as the parent claim. Inoue discloses that the telephone directory memory (6) is *manually* selected by a user after a call in order to register a telephone number. See column 5, lines 46-49. Therefore, Inoue anticipates all limitations of the claim.

Claim 8 is limited to *a telephone terminal device as claimed in any of claims 1 to 4*. Consider claim 1, as covered by Inoue, as the parent claim. As a first matter, the terms *preliminarily* and *automatically* are not related to any respective event or stimulus in the claim. Thus, Inoue discloses that a user must first activate keys to register a telephone number in the directory memory (7), such that registration occurs without further user input, i.e. in an *automatic* fashion, upon the *preliminary* request of the user. Therefore, Inoue anticipates all limitations of the claim.

Claim 9 is limited to *a telephone terminal device*. Claim 9 is limited to essentially the same matter as claim 1, as covered by Inoue. In addition, claim 9 expands on the selecting step made after a call. Inoue discloses presenting a user with the option to add a telephone number to the directory memory (6), see figure 4B. The user then indicates their desire to add the number to the directory memory (6) by actuating a key on the keypad. See column 5, lines 46-49. Therefore, Inoue anticipates all limitations of the claim.

## *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.      **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Yasuda et al. (US Patent 5,062,132).**

**Claim 3** is limited to *a telephone terminal device as claimed in claim 1*, as

covered by Inoue. Inoue briefly discloses expanding the size of the temporary memory

(7) to greater than or equal to two and that the user arbitrarily determines timing for

deleting the telephone numbers stored in the telephone number temporary memory (7).

See column 5, line 57 through column 6, line 4. Simple analysis of the solution

presented by Inoue suggests that if a user does not arbitrarily eliminate entries from

their temporary memory, the temporary memory will quickly fill up to its capacity,

removing any advantage the method disclosed by Inoue would provide. Therefore,

Inoue anticipates all limitations of the claim with the exception *wherein data of at least*

*one of the telephone directories are erased automatically after passage of a*

*predetermined time.*

The above apparent problem is well known in the art, but can simply be managed

using any number of finite data structure elements such as the implementation of a

FIFO buffer. The examiner takes Official Notice of the fact that FIFO buffers were well

known at the time of the invention. As an example, Kurosawa teaches a method for

storing frequently used telephone numbers where a FIFO is used and also where a time

stamp is kept for each phone number. See figure 4. Kurosawa teaches that after the

passage of a predetermined time, the temporary storage memory, which corresponds to

the temporary storage memory of Inoue, is updated such that all entries dated past a

certain time threshold are removed from the temporary storage memory. In this

manner, buffer overflow is reduced, and old numbers are eliminated, which also

generates a degree of privacy over telephone use. See page 12, line 29 through page

13, line 13.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to time stamp each telephone number stored in the temporary memory such

that old numbers are erased after passage of a predetermined time as taught by

Kurosawa for the purpose of reducing overflow of the temporary buffer, which would

inherently affect the operation and effectiveness of the invention of Inoue.

3.       **Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in**

         **view of Yasuda et al. (US Patent 5,062,132).**

**Claim 5** is limited to *a telephone terminal device as claimed in any of claims 1 to*

*4.* Consider claim 1, as covered by Inoue, as the parent claim. Inoue simply teaches a

method for adding new telephone numbers to an existing telephone number directory

while avoiding overlapping numbers. There is no indication that an external directory is

interfaced with the cellular phone disclosed therein. Therefore, Inoue anticipates all

limitations of the claim with the exception of *an interface means for connection with an*

*external memory device external to said terminal device.*

Yasuda discloses a telephone apparatus providing for automatic transfer of

stored data between handsets. See Abstract. Yasuda recognizes that while automatic

dialing directories are very convenient for assisting a telephone terminal user in

remembering a large number of telephone numbers, an unforeseen circumstance

resulting in the need to replace the programmed terminal device forces a user to reenter

each number in the same fashion the original device had to be programmed. See

column 1, lines 13-45. Yasuda simply resolves this by enabling a user to transfer existing memory of a first device to a second device by way of an interface and communication channel, such as a cable, as seen in figure 2. Also see column 1, lines 49-61.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the interface (18) as taught by Yasuda for the purpose of enabling memory from a first device to be transferred to a second device such that replacement of the first device with the second device does not require the user to reprogram the second device in the same manner as the first.

**Claim 6** is limited to *a telephone terminal device as claimed in claim 5*, as covered by Inoue in view of Yasuda. Since the directory memory of the first device is copied directly to the directory memory of the second device according to the method disclosed by Yasuda, see figure 3, it follows that *at least one of the telephone directory memories comprises the external memory device connected with a telephone terminal device main body via the interface means*. Therefore, Inoue in view of Yasuda makes obvious all limitations of the claim.

## Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

4.      Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Claim 4** is limited to *a telephone terminal device as claimed in claim 1*, as covered by Inoue. Inoue discloses transferring numbers from a temporary storage memory, i.e. *a transmitted telephone number record directory memory*, to a directory memory, i.e. *a buffer memory*. However, the transfer is not in response to the transmitted telephone number record directory memory having insufficient space for the storage of a new telephone number. Thus, claim 4 is allowable over Inoue.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-9, filed 25 October 2004, have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

WFB
4/11/05

**SINH TRAN**
**SUPERVISORY PATENT EXAMINER**